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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,883	02/19/2002	Raymond John Balzer	10010880-1	6255

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AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

EXAMINER

TRIMMINGS, JOHN P

ART UNIT	PAPER NUMBER
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2138

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/078,883

Applicant(s)

BALZER, RAYMOND JOHN

Examiner

John P. Trimmings

Art Unit

2138

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-52 is/are rejected.
- 7) ☒ Claim(s) 29, 39, 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the applicant's amendment dated 11/28/2005.

The applicant has amended Claims 43-52.

Claims 27-52 are pending.

Response to Amendment

As per the Claim Objections:

1. In view of the amendments to Claims 44-52, the examiner withdraws the objection to said claims.

As per 35 USC 112 First Paragraph:

2. In view of the argument in regard to the rejection of Claim 43 under 35 USC 112 first paragraph, the examiner finds the argument persuasive and withdraws the rejection of said claim.

As per 35 USC 112 Second Paragraph:

3. In view of the argument in regard to the rejection of Claims 31 and 41 under 35 USC 112 second paragraph, the examiner finds the argument persuasive and withdraws the rejection of said claims.

As per 35 USC 102:

4. Applicant's arguments filed 11/28/2005 have been fully considered but they are not persuasive. The applicant has relied on one point of argument in regard to the three independent Claims, 27, 35 and 43, and the examiner disagrees with the applicant's argument as follows:

The applicant argued that the "AAPA" (applicant's admitted prior art) failed to disclose "the TAP controller being transitioned from any of at least three undetermined controller states" (see page 8, 9 and 10 of Remarks). The examiner, in order to support the rebuttal, includes the definition stated by the applicant in the Remarks, that "at least three states" means "three or more states" (see page 8 paragraph 2).

The applicant, in the argument, contends that the intended meaning of the underlined phrase ("the TAP controller being transitioned from any of at least three undetermined controller states") is that the AAPA must transition from each of 3 or more undetermined states. The examiner does not agree with the applicant's interpretation of the meaning of the underlined phrase. The following reasoning shows that the meaning of the claimed limitation is not what the applicant intends it to mean.

The phrase, "any of three or more" is very broad, and means:

- a. One of three or more", or
- b. Two of three or more, or,
- c. Three of three or more, or,
- d. Four of three or more, or ...

Since this group of choices is in the alternative, the examiner has chosen the first choice ("one of three or more") in the rejections, and is not required to selected any other alternative.

The choice, placed into the underlined phrase above is;
"the TAP controller being transitioned from **one of three or more** undetermined controller states". The examiner, in choosing the teaching of the AAPA that the TAP controller transitions from the UPDATE_DR state to another determined state (page 10 of application supports this), has met all of the requirements of the claim (transitioned from one of three or more), and therefore the AAPA reference anticipates "one of three or more".

In other words, the applicant's choice of "any" (as opposed to "each" for example) has created an open-ended and broad limitation in the subject claims in which the examiner may choose the one of "any" in a citation that meets such a broad limitation. Therefore, the examiner maintains the rejections of Claims 27, 35 and 43 under 35 USC 102, and all subsequent dependent claims. In all, Claims 27-52 are maintained as rejected as outlined in the examiner's previous office action dated 8/24/2005.

Claim Objections

5. Claim 29 is objected to because of the following informalities: The claim is dependent on Claim 28, which contains a transitional phrase ("consisting of") that excludes any further limitation. In other words, in view of the wording of Claim 28, the limitations of the three undetermined controller states are closed, therefore, Claim 29

Art Unit: 2138

should be either cancelled or amended to correct the defect. Appropriate correction is required. (See MPEP 2111.03[R3], Transitional Phrases).

6. Claim 39 is objected to because of the following informalities: The claim is dependent on Claim 38, which contains a transitional phrase ("consisting of") that excludes any further limitation. In other words, in view of the wording of Claim 38, the limitations of the three undetermined controller states are closed, therefore, Claim 39 should be either cancelled or amended to correct the defect. Appropriate correction is required. (See MPEP 2111.03[R3], Transitional Phrases).

7. Claim 41 is objected to because of the following informalities: The claim is dependent on Claim 38, which contains a transitional phrase ("consisting of") that excludes any further limitation. In other words, in view of the wording of Claim 38, the limitations of the three undetermined controller states are closed, therefore, Claim 41 should be either cancelled or amended to correct the defect. Appropriate correction is required. (See MPEP 2111.03[R3], Transitional Phrases).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

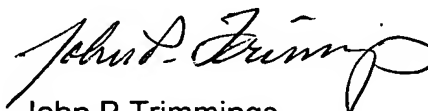
Art Unit: 2138

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Trimmings whose telephone number is (571) 272-3830. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P Trimmings
Examiner
Art Unit 2138



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